



#6 Response  
P.D.  
3-5-03

Response Under 37 C.F.R. § 1.116(a)  
EXPEDITED PROCEDURE  
Examining Group Art Unit 3625

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Dated: February 19, 2003

STEPHEN D. DENTEL,  
MICHAEL D. WHITMARSH,  
JOHNATHAN R. VOGT  
and KIRSTEN B. WISDOM

HP Docket No. 10992740-1

Serial No. : 09/629,254 ✓

Group Art Unit 3625

Filed : July 31, 2000

Examiner Jeffrey A. Smith

For : SYSTEM AND METHOD FOR FACILITATING THE  
PURCHASE OF COMPATIBLE PRODUCTS

Assistant Commissioner for Patents  
**Box AF**  
Washington, D.C. 20231

**RECEIVED**

MAR 03 2003

**GROUP 3600**

Sir:

**RESPONSE TO OFFICE ACTION**

Reconsideration of the Office action dated December 13, 2002 and allowance of all pending claims are respectfully requested in view of the following remarks.

Applicants initially note that claims 1-23, 25 and 29-33 stand rejected under 35 USC 102(e) as being anticipated by Gronemeyer et al. (U.S. Patent No. 6,363,359). Claims 24 and 26-28 stand rejected under 35 USC 103(a) as unpatentable over Gronemeyer et al. (U.S. Patent No. 6,363,359) in view of Benjamin et al. (U.S. Patent No. 6,113,208).

In their previous Response to Office Action (dated October 9, 2002), applicants responded to identical rejections under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) with a Declaration of Stephen D. Dentel prepared pursuant to 37 C.F.R. § 1.131. Applicants had noted, that Gronemeyer et al. (U.S. Patent No. 6,363,359)

indicates a filing date of December 21, 1999, a date less than 8 months prior to the filing date of applicants' pending application. Furthermore, applicants noted that conception of their invention preceded the filing date of Gronemeyer et al., and that they had diligently worked toward reducing their invention to practice from a time prior to the filing date of Gronemeyer et al. Applicants thus asserted that their invention thus precedes the effective date of Gronemeyer et al.

In the present Office action, the Examiner notes that the Declaration of Stephen D. Dentel does not overcome the rejection as it is made by less than all named inventors of the application. Without conceding that 37 C.F.R. § 1.131 does require signature of all named inventors, applicants hereby submit a new Declaration Under § 1.131 in accordance with the Examiner's direction.

Accordingly, the attached Declaration Under § 1.131 is made by all inventors and includes signatures of all inventors. The Declaration Under § 1.131 is submitted for the purpose of establishing invention of the subject matter of the rejected claims prior to the effective date of Gronemeyer et al. This declaration indicates conception at least as early as August 1999, when applicants began giving presentations regarding the invention to potential partners in developing a commercial implementation of the invention. Documentation demonstrating one such presentation is attached as Exhibit 1 to the Declaration Under § 1.131, such documentation bearing a date of October 11, 1999 (a date prior to the effective date of Gronemeyer et al.).

Following applicants' conception of the invention (and prior to the effective date of Gronemeyer et al.), applicants diligently worked toward reduction to practice of the invention. Such diligence is demonstrated by the Declaration Under § 1.131,

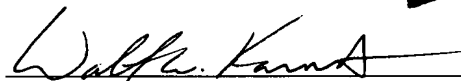
and by the presentation documentation attached thereto as Exhibit 1. A commercial embodiment of the invention was completed by applicants' employer (and an implementation partner, AOL) in early 2000, and was released to the public for use in August 2000, further demonstrating applicants' diligence.

Therefore, in view of the attached Declaration Under § 1.131 (and its Exhibit 1), Gronemeyer et al. should not be considered as prior art, and the Examiner's rejections under both 35 USC 102(e) and 35 USC 103(a) should be withdrawn.

The above remarks are believed to address fully the Examiner's rejections, and to place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

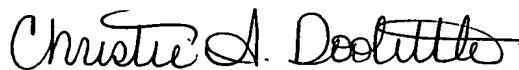


Walter W. Karnstein  
Registration No. 35,565  
Customer No. 23581  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Attorney for Applicants

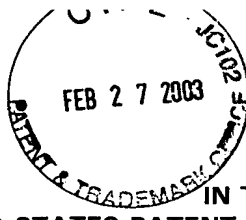


CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on February 19, 2003.



Christie A. Doolittle  
Date of Signature: February 19, 2003



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Stephen D. Dentel et al.

Confirmation No.:

Application No.: 09/629,254

Examiner: J. Smith

Filing Date: July 31, 2000

Group Art Unit: 3625

Title: SYSTEM AND METHOD FOR FACILITATING THE  
PURCHASE OF COMPATIBLE PRODUCTS

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

RECEIVED

MAR 03 2003

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

GROUP 3600

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
(X) No additional fee (Address envelope to "Box Non-Fee Amendments")  
(X) Other: Declaration Under § 1.131 (and Exhibit 1) (fee \$           )

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	33	MINUS	33	= 0	X \$18	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$84	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$410.00	3RD MONTH \$930.00	4TH MONTH \$1450.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: Feb. 19, 2003

Typed Name: Christi A. Do little

Signature: Christi A. Do little

Respectfully submitted,

Stephen D. Dentel et al.

By Walter W. Karnstein

Walter W. Karnstein

Attorney/Agent for Applicant(s)

Reg. No. 35,565

Date: Feb. 19, 2003